

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bampton et al.
Application No.: 10/732,882
Filing Date: December 10, 2003
Group Art Unit: 1742
Examiner: Ip, Sikyin
Title: OXIDATION RESISTANT AND BURN RESISTANT
COPPER METAL MATRIX COMPOSITES

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Dear Sir:

The following remarks are made in reply to the Examiner's Answer dated 19 December 2008. A corrected Appeal Brief is also being filed for the reasons discussed below. The appeal Brief fee has already been paid. Any additional fees or credit may be charged to Deposit Account No. 21-0279 in the name of United Technologies Corporation.

REMARKS

Respectfully, the Examiner's Answer raises numerous additional issues that require a brief response as follows.

Regarding Appellant's argument under Section I of the Appeal Brief against the 112, first paragraph rejection, the Examiner argues that if Appellants had intended to exclude unrecited elements, the Appellants should have used "consisting of" transitional language. Respectfully, the transitional term "consisting of" relates to claim language and is inconsequential in

determining whether the specification as a whole demonstrates possession of the claimed range. As Appellants have pointed out, the examples given in the specification demonstrate possession of the claimed range with example over the entire range.

Regarding Appellant's arguments under Sections II and III of the Appeal Brief related to the effect of the other elements on burn resistance in the cited references, the Examiner argues (p.10 Examiners Answer) that the appealed claims contain aluminum and titanium, which have lower threshold pressures than iron and lead according to the Sinclair article. Respectfully, the issue in contention is not whether Ti and Al influence burn resistance but whether the elements included in the composition of the cited reference that are not in the claimed composition materially affect the burn resistance. Thus, it is inconsequential whether the claimed composition contains Ti and Al. As noted, the Sinclair article establishes that Fe and Pb, which are in the composition of the cited reference but not within the claimed composition, may have a negative affect on burn resistance. Additionally, even considering the Ti and Al, one would not add additional elements having a negative influence on burn resistance if trying to achieve a particular burn resistance.

The Examiner also argues that the argument of appealed dependent claim 26 does not comply with the appeal brief rules 37 CFR 41.37 (c)(1)(v) (see Examiner's Answer page 11). However, Appellant notes that part in section (c)(1)(v) that the Examiner highlighted applies to means plus function or step plus function limitations. Claim 26 is not a means plus function claim and therefore the cited section of the Appeal Brief rules does not apply.

Regarding Appellant's argument for claim 26 in Sections II and III of the Appeal Brief, the Examiner calculates the claimed volume percentage in terms of weight percent for comparison to the range of the cited reference. However, as even the Examiner notes, the calculated claimed weight percent from claim 26 (32.8wt%) is higher than the disclosed range in Takagi (2-30wt%). Therefore, even by the Examiner's calculations, the ranges do not overlap. Furthermore, the Examiner has not provided any evidentiary support that the claimed range is so close to the disclosed range that one of ordinary skill in the art would view these as being substantially identical. Indeed, having almost 3wt% more of the reinforcing agent would appear to provide a greater reinforcing effect than the range in the cited reference.

Regarding Appellants' argument for claim 47 under Sections II and III of the Appeal Brief, it has come to the Appellant's attention that claim 47 was only rejected over Takagi, and not Kondoh, according to the final rejection. A corrected Appeal Brief is filed herewith to correct the "Grounds of Rejection" section. Furthermore, although the final rejection lists claim 47 as being rejected, there is no explanation of how the cited reference is applied to claim 47. Therefore, the rejection does not establish obviousness because there is no explicit reasoning stating the rationale of the rejection. *KSR International Co. v. Teleflex Inc.* 550 U.S. 398, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007).

Additionally, regarding the Examiner's argument that claim 47 uses the closed term of "consisting of" but that the term "having" is an opening expression, Appellant notes that the Examiner has previously read the claim to be closed (see Advisory Action comments stating that "claim 47 for example, are excluding carbides which include boron carbide"). Thus, the Examiner seems to recognize that the term "consisting of" in the preamble of the claim controls and closes the entire claim.

CLOSING

For all of the reasons set forth above, and the reasons set forth in Appellants' Appeal Brief, the rejection of the claims is improper and should be reversed.

Respectfully submitted,
CARLSON, GASKEY & OLDS

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